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UNITED STATES PATENT AND TRADEMARK OFFICE

In re Genji IMAI et al.

U.S. Application No.: 10/590,737

Filed: August 25, 2006

Attorney Docket No.: 7398/88285

Confirmation No. Not Yet Assigned

Customer No.: 42798

**SUBMISSION OF ENGLISH TRANSLATION OF
INTERNATIONAL PRELIMINARY REPORT**

Commissioner for Patents
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314


Sir:

Applicants submit herewith a copy of the English translation of the International Preliminary Examination Report issued for the basic PCT application of the above-referenced application.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

Date: **February 22, 2007**


Kendrew H. Colton
Registration No. 30,368

OFFICIAL CORRESPONDENCE TO
Customer No. 42798
FITCH, EVEN, TABIN & FLANNERY
One Lafayette Centre
1120 20th Street, NW, Suite 750 South
Washington, DC 20036
Tel: 202/419-7000
Fax: 202/419-7007

TRANSLATION**PATENT COOPERATION TREATY****PCT****INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference KSP05P056	FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. PCT/JP2005/003002	International filing date (day/month/year) 24.02.2005	Priority date (day/month/year) 25.02.2004
International Patent Classification (IPC) or national classification and IPC C08F265/04 (2006.01) , C08F2/44 (2006.01) , G02B6/12 (2006.01) , G02B6/13 (2006.01)		
Applicant KANSAI PAINT CO., LTD.		

<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>5</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> (sent to the applicant and to the International Bureau) a total of _____ sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>																									
<p>4. This report contains indications relating to the following items:</p> <table><tr><td><input checked="" type="checkbox"/></td><td>Box No. I</td><td>Basis of the report</td></tr><tr><td><input type="checkbox"/></td><td>Box No. II</td><td>Priority</td></tr><tr><td><input type="checkbox"/></td><td>Box No. III</td><td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td></tr><tr><td><input type="checkbox"/></td><td>Box No. IV</td><td>Lack of unity of invention</td></tr><tr><td><input checked="" type="checkbox"/></td><td>Box No. V</td><td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td></tr><tr><td><input type="checkbox"/></td><td>Box No. VI</td><td>Certain documents cited</td></tr><tr><td><input type="checkbox"/></td><td>Box No. VII</td><td>Certain defects in the international application</td></tr><tr><td><input type="checkbox"/></td><td>Box No. VIII</td><td>Certain observations on the international application</td></tr></table>		<input checked="" type="checkbox"/>	Box No. I	Basis of the report	<input type="checkbox"/>	Box No. II	Priority	<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI	Certain documents cited	<input type="checkbox"/>	Box No. VII	Certain defects in the international application	<input type="checkbox"/>	Box No. VIII	Certain observations on the international application
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Date of submission of the demand	Date of completion of this report																								
Name and mailing address of the IPEA/JP	Authorized officer																								
Facsimile No.	Telephone No.																								

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/JP2005/003002

Box No. I

Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language _____ which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:
- ☒ the international application as originally filed/furnished
- ☐ the description:
- pages _____ as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☐ the claims:
- nos. _____ as originally filed/furnished
- nos.* _____ as amended (together with any statement) under Article 19
- nos.* _____ received by this Authority on _____
- nos.* _____ received by this Authority on _____
- ☐ the drawings:
- sheets _____ as originally filed/furnished
- sheets* _____ received by this Authority on _____
- sheets* _____ received by this Authority on _____
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

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Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	2-9	YES
	Claims	1	NO
Inventive step (IS)	Claims		YES
	Claims	1-9	NO
Industrial applicability (IA)	Claims	1-9	YES
	Claims		NO
2. Citations and explanations (Rule 70.7)			
Document 1: JP 2003-29404 A (Mitsubishi Chemical Corp.), 29 January 2003, paragraphs [0016], [0017], [0022], [0032] to [0034] and [0100]			
Document 2: JP 6-208033 A (Japan Synthetic Rubber Co., Ltd.), 26 July 1994, paragraphs [0001] and [0090]			
Document 3: JP 10-147614 A (Sumitomo Chemical Co., Ltd.), 02 June 1998, paragraphs [0029] and [0030]			
Document 4: JP 2003-104982 A (Japan Tobacco Inc.; Agouron Pharmaceuticals, Inc.), 09 April 2003, paragraphs [0103] and [0104] & EP 984000 A1 & US 5962704 A			
Document 5: JP 2003-202437 A (JSR Corp.), 18 July 2003, claims 1 to 7			
<p>The invention set forth in claim 1 lacks novelty and does not involve an inventive step in the light of document 1 cited in the international search report. Document 1 discloses a resin composition for use in an optical waveguide element, and said resin composition contains a photopolymerization initiator (which corresponds to component (C) of the invention set forth in the present application), a monomer that includes an</p>			

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Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

ethylenically unsaturated compound (which corresponds to component (B) of the invention set forth in the present application) and a binder that includes a copolymer of a maleic anhydride and an acrylic acid derivative (which corresponds to component (A) of the invention set forth in the present application).

With regards to the "maleic anhydride" in the invention set forth in the present application, the description of the present application presents maleic anhydride as an example of the radical polymerizable compound (a1) that constitutes copolymer (A) of the invention set forth in the present application (refer to paragraph [0017]). Furthermore, with regards to the radical polymerizable compound (a1) that contains an acid anhydride, which is typified by maleic anhydride, the description of the present application indicates that the acid anhydride is not "blocked" (refer to paragraph [0015]). Such being the case, the assertions made by the applicant in the written response dated 21 December 2005 are not applicable.

The invention set forth in claim 2 does not involve an inventive step in the light of document 1 and document 2 cited in the international search report. Document 2 discloses inventions for producing resin optical waveguides, wherein the phenolic hydroxy group is substituted with a butyl group or the like and then protected (this process corresponds to "blocking" the acid radical). Such being the case, a person skilled in the art could configure the invention set forth in claim 2 by using a compound that includes a blocked phenolic hydroxy group, like the compounds disclosed in document

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Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

2, instead of the compound that includes an acid anhydride group as the radical polymerizable compound that constitutes the binder in the invention disclosed in document 1, as appropriate.

The invention set forth in claim 3 does not involve an inventive step in the light of documents 1 to 4 cited in the international search report. Compounds that contain ether-linked olefinically unsaturated groups (e.g., vinyl ethers and the like) are known to be useful as blocking agents for blocking an acid radical.

The inventions set forth in claims 4 to 9 do not involve an inventive step in the light of documents 1 to 5 cited in the international search report. Document 5 discloses a technique whereby a resin composition is converted into a dry film for use in a waveguide.